

REMARKS

Favorable reconsideration of this application is respectfully requested.

The Examiner is thanked for indicating that claims 15-21 are allowable.

Applicant thanks the Examiner for the courtesies extended to Applicant's representative during a September 25, 2003, telephone interview in which the outstanding Office Action was discussed. Applicant's separate record of the substance of the interview is contained in the comments below.

As a result of the Response to Restriction Requirement, filed April 14, 2003, claims 15-45 are under review. In the July 3, 2002, Office Action, only claims 15-21 and 40-44 were addressed. As is clear from the Response to Restriction Requirement, Applicant elected Group II, claims 15-45, and Species A, claims 1-45. Thus, the relevant claims include all of claims 15-45. The generic claims were further identified as claims 15-21 and 40-44. These were the only claims addressed. Thus, Applicant respectfully requests that all of claims 15-45 be considered and addressed in a second non-final Office Action.

Claims 40-44 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,301,506 to den Boer *et al.* This rejection is respectfully traversed.

The rejection of claims 40-44 under 35 U.S.C. § 102(b) as being anticipated by den Boer is improper, because the rejection under 35 U.S.C. § 102(b) set forth in the Office Action on its face did not and could not meet the requirements of § 102(b). The requirement of 35 U.S.C. § 102(b) is, as stated in the Manual of Patent Examining Procedure (MPEP), **"TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM."** (MPEP § 2131 (8th ed. 2001) (emphasis in original); *see In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102(b), every element of the claimed invention must be identically shown in a single reference.") (quoting *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 U.S.P.Q.2d (BNA) 1315, 1317 (Fed. Cir. 1988)); *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2

U.S.P.Q.2d (BNA) 1051, 1053 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”); *W.L. Gore and Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. (BNA) 303, 313 (Fed. Cir. 1983) (“Anticipation requires that the disclosure in a single prior art reference of each element of the claim under consideration.”)). In addition, the single prior reference must disclose each element of the claimed invention “as arranged in the claim.” (*Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 U.S.P.Q. (BNA) 481, 485 (Fed. Cir. 1984); *see* MPEP § 2131).


Claim 40 recites an apparatus for use in anti-cancer treatments, comprising means for exposing both normal and diseased tissues to EM fields for a minimum of 20 minutes, with the field exposure ending at a maximum of 10 hours prior to treatment with therapeutic agents. It is clear that none of the elements of claim 40 were addressed in the rejection. The Examiner simply made the conclusory statement that “Claims 40-44 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by den Boer et al. (U.S.pat.6,301,506)”. Conclusory statements are insufficient to establish a *prima facie* rejection. (*See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002) (stating the Board’s general conclusions in making its decision is insufficient)).

Furthermore, den Boer does not address the use of fields as a pretreatment prior to use of therapeutic agents as recited in claim 40. Thus, den Boer fails to teach or suggest all the elements of claim 40.

For the above reasons, the rejection of claims 40-44 under 35 U.S.C. § 102(b) based on den Boer *et al.* is *prima facie* improper and technologically insufficient and should therefore be withdrawn.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Steven J. Prewitt at 703-591-2664, Ext. 2003. In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,


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